

Serial No.: 09/995,678

REMARKS**INTRODUCTION:**

In accordance with the foregoing, claims 1-3 have been amended. No new matter is being presented, and approval and entry are respectfully requested. Support for the amendments to claims 1-3 can be found, for example, in the Specification at page 14, lines 3-16, and lines 21-27.

Claims 1-20 are pending and under consideration. Claims 14-20 were allowed. Claims 1-13 are rejected. Reconsideration is requested.

Further, the examiner has not yet indicated that the submitted drawings have been accepted. Applicants respectfully request that the Examiner accept the submitted drawings.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response because the amendments were not earlier presented because Applicants believed in good faith that the cited prior art did not disclose the present invention as previously claimed.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTIONS UNDER 35 U.S.C. §102:

In the Office Action, at page 2, paragraph 2, the Examiner rejected claims 1-4, 6 and 12 under 35 U.S.C. §102 (e) as being anticipated by Ouchi et al. (U.S. Patent No. 6,299,542 – hereinafter Ouchi). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Serial No.: 09/995,678

Amended, independent claim 1 recites: "...the outer race being made of a medium carbon steel; and each post-hardening cut surface having a surface roughness not greater than 0.8."

Amended claim 2 recites: "...the inner race is made of a case hardening steel; and each post-hardening cut surface has a surface roughness not greater than 0.8.

And amended claim 3 recites: "...the retainer is made of a case hardening steel; and each post-hardening cut surface has a surface roughness not greater than 0.8.

Applicants respectfully submit that the medium carbon steel of the outer race, as claimed in claim 1, is suitable for hardening. Additionally, Applicants respectfully submit that the case hardening steel of the inner race (as claimed in claim 2) and the retainer (as claimed in claim 3) is suitable for hardening, for example, carburizing.

Applicants respectfully submit that Ouchi neither discloses nor suggests an outer race made of a medium carbon steel and having post-hardening cut surfaces with a surface roughness not greater than 0.8

Applicants further submit that Ouchi neither discloses nor suggests an inner race made of a case hardening steel and having post-hardening cut surfaces with a surface roughness not greater than 0.8, or a retainer made of a case hardening steel and having post-hardening cut surfaces with a surface roughness not greater than 0.8

Thus, Applicants respectfully submit that claim 1 patentably distinguishes over the cited art, and should be allowable for at least the above-mentioned reasons. Further, Applicants respectfully submit that claims 2-4, 6, and 12, which depend from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

REJECTIONS UNDER 35 U.S.C. §103:

In the Office Action, at page 4, first paragraph, the Examiner rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Ouchi in view of Krude (U.S. Patent No. 4,529,254 – hereinafter Krude). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Serial No.: 09/995,678

Claim 5 recites "...wherein the outer race has an inlet mouth and a rear opening opposite to the inlet mouth and having a diameter smaller than a diameter of the inlet mouth, said outer race also having a fitting flange formed therewith at a location radially outwardly of an outer periphery of the inlet mouth and a cylindrical mount formed therewith to protrude axially outwardly from the opening, wherein the propeller shaft extends through the rear opening and is then engaged with the inner peripheral surface of the inner race."

The Examiner acknowledges that Ouchi that Ouchi does not disclose a rear opening which has a diameter smaller than a diameter of an inlet mouth, but contends that Krude does.

Applicants respectfully submit that the Examiner is misinterpreting and/or misapplying the cited references. For example, the Examiner maintains that hub 133 (Fig. 5) of Ouchi is the claimed inlet mouth. But hub 133 is not part of outer race 141, as is required by claim 5 (Ouchi col. 15, lines 56-61). Further, the Examiner maintains that second fitting flange 117 (Fig. 5) of Ouchi is the claimed fitting flange. But the second fitting flange 117 is not part of the outer race 141, as is required by claim 5. Rather, the second fitting flange 117 is part of hub body 131 (Ouchi col. 16, lines 37-40).

Accordingly, since Krude fails to cure the deficient teachings of Ouchi, Applicants respectfully submit that claim 5 patentably distinguishes over the cited art.

In the Office Action, at page 4, last paragraph, the Examiner rejected claims 7-9 under 35 U.S.C. §103(a) as being unpatentable over Ouchi in view of Yamamoto et al. (U.S. Patent No. 6,367,981 – hereinafter Yamamoto). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 5, second paragraph, the Examiner rejected claims 10-11 under 35 U.S.C. §103(a) as being unpatentable over Ouchi in view of Jacob et al. (U.S. Patent No. 5,580,313 – hereinafter Jacob). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 6, second paragraph, the Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Ouchi. The reasons for the rejection are set forth

Serial No.: 09/995,678

in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Applicants respectfully submit that claims 5, 7-11, and 13, which ultimately depend from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

CONCLUSION:

In accordance with the foregoing, Applicants respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 09 AUG 2004

By: Michael A. Bush
Michael A. Bush
Registration No. 48,893

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 9, 2004
By: STAAS & HALSEY LLP
Date: August 9, 2004